

B4
[Please amend Claim 18 as follows:]

18. The program for identifying and providing a response to use of an electronic storage medium having a tracking identifier incorporated thereon as recited in claim 11, including a code segment that posts indicia of video, user information, and a suitable player to a database.

Please cancel Claims 19 and 20 without prejudice, or disclaimer.

REMARKS

The specification and claims have been amended to correct minor informalities and to address other issues raised by the Examiner. Claims 1, 2, 6, 7, and 11 through 18 have been amended. Claims 19 and 20 have been cancelled. Eighteen claims remain pending in the application: Claims 1 through 18. Reconsideration of Claims 1 through 18 in view of the amendments above, the arguments below, and the January 22, 2001 teleconference between the Examiner and Applicant's representative is respectfully requested.

By way of this amendment, Applicant has made a diligent effort to place the claims in condition for allowance. However, should there remain any outstanding issues that require adverse action, it is respectfully requested that Examiner telephone the undersigned directly at (858)587-7644 so that such issues may be resolved as expeditiously as possible.

Turning to the specific objections and rejections:

1. At the outset, Applicant wishes to thank the Examiner for his indication that Claims 3 and 8 would be allowable if rewritten to overcome the objections under 35 U.S.C. § 112, second para., and that Claims 13, 14, and 18 would be allowable if rewritten in independent form. In view of the amendments above, remarks below, and the January 22, 2001 teleconference between the Examiner and Applicant's representative, all pending claims are now believed allowable without further amendment.

2. Applicant also wishes to thank the Examiner for his time and attention during the telephone interview of January 22, 2001. Applicant brings to the Examiner's attention an apparent error in the Interview Summary Record mailed on January 25, 2001, which indicates that the above-referenced interview took place on January 21, 2001, a Sunday. Applicant's records indicate that the telephone interview took place on January 22, 2001, a Monday.

In accordance with this telephone interview, Applicant has made some amendment to the claims in order to clarify the language "coupled to", by replacing such language with the language "accessed by". Support for this change is found throughout the specification and drawings. Further, Applicant emphasizes, in the remarks below, the unamended, but claimed features of "detecting the tracking identifiers when the electronic storage medium is accessed by **a computer**" and "determining, as a function of the tracking information, appropriate updated information utilizing logic in the server computer to transmit to **the computer** (*emphasis added*)" (such as in Claim 1). Specifically, Applicant points out that, as claimed, the "detecting" is performed "when the . . . medium is access by **a computer**", and the "determining" is of

"information . . . to transmit to **the computer**," i.e., the same computer by which the medium is accessed. As discussed during the telephone conference with the Examiner, this feature appears to be both novel and non-obvious in view of the references cited.

3. The specification stands objected to for including informalities. Amendments are submitted herewith in order to address each specific objection to the specification. Accordingly, these objections should be overcome; reconsideration and withdraw of this objection is respectfully requested.

4. Claim 20, a system claim, is rejected on the basis that it is dependent on Claim 1, a method claim. Claim 20 has been cancelled herewith, and therefore this rejection is now moot.

5. Claims 1 and 6 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the limitation "the tracking information" is rejected for lacking antecedent basis. Claims 1 and 6 have been amended to provide antecedent basis for "the tracking information."

6. Claims 2, 7 and 12 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the limitation "the retailer" is rejected for lacking antecedent basis. Claims 2, 7 and 12 have been amended to provide antecedent basis for "the retailer."

7. Claim 7 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the

limitation "the package" is rejected for lacking antecedent basis. Claim 7 has been amended to change "the package" to "the optical disk electronic storage medium," which finds antecedent basis in independent Claim 6.

8. Claim 20 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claim 20 has been cancelled, and thus this rejection is now moot.

9. Claims 1, 2, 4, 6, 7, 9, 19 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,860,068 (Cook) in view of U.S. Patent No. 5,960,398 (Fuchigami et al.). The rejections of Claims 19 and 20 are moot, as Claims 19 and 20 have been cancelled.

Cook teaches a method for manufacturing and distributing custom data products, especially a personalized audio CD product incorporating customer-selected musical sound recordings. According to Cook, a customer generates an order of a custom product through, for instance, a computer terminal having access to a network. A set of digital audio files is selected according to a customer's order, and is transmitted to one of a plurality of a CD burners in a "disk farm".

Cook teaches that a bar code or similar identifier identifying the personalized audio CD product, such as by order number, shipping method, job number, or batch number, may be printed at the burner machine and placed on the packaging (see col. 10, lines 23 through 45), and further suggests that hidden "codes" may be implanted in the sound recording to later facilitate tracking (see col. 9, lines 17 through 25).

Cook does not suggest or describe any apparatus that includes "logic that detects the tracking information when the

electronic medium is accessed by **a computer**," let alone such an apparatus that further includes "logic that transmits the tracking information [i.e., the tracking information detected when the electronic medium is accessed by **a computer**,] to a server computer," as claimed, for example in Claim 6. Cook does not teach or suggest "logic . . . that determines, as a function of the tracking information, appropriate updated information to transmit to **the computer**," as claimed by Applicant in, for example, amended Claim 6.

Moreover, although Cook teaches that a bar code may be placed on a package of an electronic medium, i.e., not on the electronic medium, this bar code is "read" only for the purpose of shipping management, i.e., order tracking, not for determining, as a function of the tracking information, appropriate updated information to transmit to **the computer** that accesses the electronic storage medium, as claimed by Applicant.

Fuchigami et al. teach a copyright information embedding system, in which information for copyright protection is embedded into a digital audio signal "without" deterioration of analog audio signal reproduced. (Presumably, this is the same reason Cook refers to "implanting" hidden codes into his sound recording, although it is not clear from Cook why this is done. See col. 9, lines 17 through 25.) The purpose of the copyright information embedding system is entirely different from the order tracking function taught by Cook. Like Cook, Fuchigami et al. do not teach or suggest "logic . . . that determines, as a function of the tracking information, appropriate updated information to transmit to **the computer**," that accesses the electronic storage medium, as claimed by Applicant in, for example, amended Claim 6. And, Fuchigami et al., like Cook, do not suggest or describe any

apparatus that includes "logic that detects the tracking information when the electronic medium is accessed by a **computer**," let alone such an apparatus that further includes "logic that transmits the tracking information to a server computer," as claimed, for example in amended Claim 6.

(Fuchigami et al. do show a decoder circuit for extracting their copyright information, however, there is no suggestion that this decoder is included in a computer, a DVD player or any similar device, or that the output of the decoder is transmitted to a server.)

Thus, reconsideration and withdraw of the present rejection is respectfully requested.

10. The Examiner further rejected Claims 5, 10 through 12, and 15 through 17 under 35 U.S.C. 103(a) as being unpatentable over Cook in view of Fuchigami et al. and U.S. Patent No. 5,892,900 (Ginter et al.).

Applicant agrees with the Examiner that neither Cook nor Fuchigami et al. teach transaction data written to a database memorializing processing as recited in the present Claims 5 and 15; a program embodied on a computer readable medium for identifying and providing a response to the use of an electronic storage medium having an identifier incorporated thereon, as recited in Claims 10 through 12, and 14 through 17; the code segment that receives live update information from the server computer as recited in Claim 16; and a code segment that reads the identifier on the electronic storage medium upon being input into a computer by a user as recited in Claim 11. Further, for the reasons stated above, the combination of Cook and Fuchigami et al. do not provide motive to make the invention claimed in Claims 1, 2, 4, 6, 7, and 9. Furthermore, the Virtual Distribution Environment of Ginter et

al., like the Video-on-Demand system of Coddington et al., provides no apparent benefit to a Cook/Fuchigami et al. combination for performing order tracking, and copyright protection. In other words, the functions of Ginter et al. are too remote from the functions of a Cook/Fuchigami et al. combination to suggest the claimed invention. At most a Cook/Fuchigami et al./Ginter et al. combination suggests three separate and distinct functions, i.e., order tracking, copyright protection, and electronic distribution; not the delivery of updated information to **a computer** based on tracking information detected upon accessing of an electronic storage medium by **the computer**, as claimed by Applicant. Therefore, the combination of Ginter et al. with Cook and Fuchigami et al. will not render the present Claims 5, 10 through 12, and 14 through 17 obvious to one of ordinary skill at the time the invention was made.

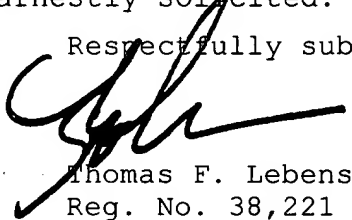
Applicant(s) acknowledge the objections made to the drawings in the NOTICE OF DRAFTSPERSON'S PATENT DRAWINGS REVIEW. Formal drawings will be forwarded to the U.S. Patent and Trademark Office upon receipt of a NOTICE OF ALLOWABILITY.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "**Version with markings to show changes made.**"

Amendment
S.N. 09/295,856
Page 13

In view of the above, and in view of the telephone interview between the Examiner and Applicant's representative on January 22, 2001, Applicant submits that Claims 1 through 18 are now in condition for allowance, and prompt and favorable action is earnestly solicited.

Respectfully submitted,



Thomas F. Lebens
Reg. No. 38,221
March 5, 2001

Address all correspondence to:
FITCH, EVEN, TABIN & FLANNERY
120 So. LaSalle Street, Suite 1600
Chicago, Illinois 60603

Direct telephone inquiries to:
Thomas F. Lebens
(858) 587-7644 (direct)
La Jolla, California Office of
FITCH, EVEN, TABIN & FLANNERY

Version With Markings to Show Changes Made

In the specification:

Paragraph beginning at page 11, lines 19, is deleted.

Paragraph beginning at page 34, line 29, has been amended as follows:

Using the Retailer/Store information, the appropriate e-commerce URL can be determined from Retailer table 570 that contains information specific for that Retailer:

Retailer/Store	Hollywood Video, Store #23
E-Commerce URL	http:// www.retailer23.com/...

In the claims:

Claim 1 has been amended as follows:

1. (twice amended) A method for tracking the distribution of content electronically, comprising the steps of:

- (a) incorporating an electronic storage medium tracking identifier onto an electronic storage medium;
- (b) incorporating a package tracking identifier onto a package in which the electronic storage medium is stored;
- (c) storing [the] tracking information [identifiers] in a database;
- (d) detecting the tracking identifier [information] when the electronic storage medium is accessed by [coupled with] a computer;

(e) transmitting, as a function of the tracking identifier having been detected, [the] tracking information to a server computer; and

(f) determining, as a function of the tracking information having been transmitted to the server computer, appropriate updated information utilizing logic in the server computer to transmit to the computer.

Claim 2 has been amended as follows:

2. (amended) A method for tracking the distribution of content electronically as recited in claim 1, wherein the server computer performs a table lookup to determine a [the] retailer that sold the package.

Claim 6 has been amended as follows:

6. (twice amended) An apparatus for tracking the distribution of content electronically, comprising,

(a) an optical disc electronic storage medium having a burst cut area; and

(b) a digital code stored in the burst cut area;

(c) the digital code representative of a tracking identifier of content on the optical disc electronic storage medium;

(d) the apparatus including logic that detects the tracking identifier [information] when the electronic storage medium is accessed by [coupled with] a computer;

(e) the apparatus including logic that transmits, as a function of the tracking identifier, [the] tracking information to a server computer; and

(f) the apparatus including logic in the server computer that determines, as a function of the tracking

information, appropriate updated information to transmit to the computer.

Claim 7 has been amended as follows:

7. (amended) An apparatus for tracking the distribution of content electronically as recited in claim 6, wherein the server computer performs a table lookup to determine a [the] retailer that sold the optical disk electronic storage medium [package].

Claim 11 has been amended as follows:

11. (twice amended) A program embodied on a computer readable medium for identifying and providing a response to the use of an electronic storage medium having a tracking identifier incorporated thereon, and a package having a tracking identifier thereon, the program comprising:

(a) a code segment that reads the tracking identifier of the electronic storage medium upon being input into a computer by a user;

(b) a code segment that detects, as a function of the tracking identifier, [the] tracking information when the package is accessed by [coupled with] a computer;

(c) a code segment that transmits the tracking information to a server computer; and

(d) a code segment in the server computer that determines, as a function of the tracking information, appropriate updated information to transmit to the computer.

Claim 12 has been amended as follows:

12. (amended) The program for identifying and

providing a response to use of an electronic storage medium having a[n] tracking identifier incorporated thereon as recited in claim 11, wherein the server computer performs a table lookup to determine a [the] retailer that sold the package.

Claim 13 has been amended as follows:

13. (amended) The program for identifying and providing a response to use of an electronic storage medium having a[n] tracking identifier incorporated thereon as recited in claim 11, wherein the server computer performs a table lookup to determine one or more authorized titles.

Claim 14 has been amended as follows:

14. (amended) The program for identifying and providing a response to use of an electronic storage medium having a[n] tracking identifier incorporated thereon as recited in claim 11, wherein the server computer initiates authorized playback of authorized information utilizing a transaction from the server computer.

Claim 15 has been amended as follows:

15. (amended) The program for identifying and providing a response to use of an electronic storage medium having a[n] tracking identifier incorporated thereon as recited in claim 11, wherein a transaction is written to a database memorializing processing.

Claim 16 has been amended as follows:

16. (amended) The program for identifying and providing a response to use of an electronic storage medium

having a[n] tracking identifier incorporated thereon as recited in claim 11, including a code segment that receives live update information from the server computer.

Claim 17 has been amended as follows:

17. (amended) The program for identifying and providing a response to use of an electronic storage medium having a[n] tracking identifier incorporated thereon as recited in claim 11, including a code segment that transmits an informational banner to the computer.

Claim 18 has been amended as follows:

18. (amended) The program for identifying and providing a response to use of an electronic storage medium having a[n] tracking identifier incorporated thereon as recited in claim 11, including a code segment that posts indicia of video, user information, and a suitable player to a database.

Claims 19 and 20 have been cancelled without prejudice or disclaimer.